

wherein said removable midsole section is removable from said shoe.

REMARKS

This amendment is responsive to the Office Action dated September 25, 2002. Claim 25 has been amended. Claims 11-44 are currently pending in the present application.

The drawings have been objected to on the basis that the mechanical fasteners, snap fit and combinations thereof as stated in claim 24 are not shown. A proposed new Fig. 11Q was submitted on September 4, 2002 in response to this rejection. As yet, the Examiner has not responded to the submission of the proposed new Fig. 11Q on September 4, 2002. It is considered that the submission of this proposed new figure overcomes the objection.

The applicant has noted the Examiner's comments on the lengthy specification. However, the applicant wishes to defer modification of the specification until all claims are allowable to avoid deletion of subject matter from the specification, which could later prove useful in the prosecution of this application.

Claims 11, 14-20, 22 and 25-31 have been rejected under 35 U.S.C. §102(b) as being anticipated by WO 97/46127 (Adidas AG). This rejection is respectfully traversed and reconsideration is requested for the reasons, which follow.

Claim 11 of the present application requires, "An inner shoe which comprises a removable midsole section sized to fit inside and form part of the sole of a shoe

designed to receive and retain said removable midsole section ...wherein said inner shoe is removable from said shoe in order to wear said inner shoe separately from said shoe." The Adidas AG invention is a method for permanently assembling a shoe outer sole, midsole, upper, and toe piece. Adidas AG does not teach or suggest a removable inner shoe, as claimed in claim 11.

The Examiner makes numerous references to a "removable midsole orthotic" in the Office Action. It is presumed that these numerous references are an error on the part of the Examiner and the applicant has thus treated these references as references to a "removable midsole section" for the purpose of preparing this response.

Specifically, the Examiner relies on a combination of midsole 12 and outsole 14 of Adidas AG as together forming a "removable inner shoe" as claimed in claim 11.

However, Adidas AG teaches at page 12, lines 7-13 that,

"The outsole [14] is then attached to the upper by a stitch 80 that weaves around the outer perimeter of the openings thereby connecting the upper 16 to the outsole flanges (e.g., flange 70 in Fig. 8) and the attachment surface 68 (in FIG. 6) of the outsole [14]. In addition, an adhesive can be applied to the attachment surface and/or the interior receiving surface of the upper before the outsole [14] is inserted into the upper to provide an additional bond between the upper and the outsole [14]."

Also, Adidas AG states that,

"the midsole [12] is then inserted into the interior cavity of the upper and affixed to the top side of the outsole [14] ... An adhesive can be used on the bottom side of the midsole 12 to secure the midsole [12] to the outsole [14]. ... A last 82 is then inserted into the cavity of the upper in order to apply pressure to the midsole [12] to strengthen the bond between the midsole [12] and the outsole [14] ..."

Clearly the outsole 14 of Adidas AG is permanently attached to the upper and thus is not removable. Also, the midsole 12 of Adidas AG is permanently affixed to the outsole 14 and thus is also not removable. Thus, Adidas AG does not teach the inner shoe as claimed in the present claims since the midsole 12 of Adidas AG is permanently attached to the outsole 14, which, in turn, is permanently attached to the upper. Therefore, the combination of elements 12 and 14, relied upon by the Examiner as anticipating the claimed removable inner shoe, is not removable. If these elements of the shoe sole of Adidas AG were removed by, for example, destroying the permanent attachment between the outsole and the upper, it would render the shoe unsuitable for its intended purpose since the shoe would be irreversibly damaged.

The removable midsole section of the present invention may be releasably attached to the sole through one or a plurality of means, including, but not limited to, mechanical fasteners, snap fittings, adhesives, etc. It should be noted that a key property for each of these methods of attachment is releasability. That is, the method of attachment must not only hold the removable midsole section and shoe together, but also allow the removable midsole section and shoe to be separated without destroying either component. For example, if an adhesive were used as the method of attachment, the bonding capacity of the glue must be "tacky" (similar to the adhesive of a Post-It™ note) so that removable midsole section may be readily secured and released without causing damage to the removable midsole section or the shoe itself.

"Anticipation" under 35 U.S.C. § 102(b) is established only when single prior art reference discloses, expressly or under principles of inherency, each and every element of claimed invention. See *RCA Corp., supra*. Because Adidas AG does not teach or suggest the removable feature of the removable midsole section of the present invention, it clearly cannot anticipate claim 11, or any of claims 14-20 and 22, all of which depend from claim 11.

Finally, the Examiner appears to take the alternative position that the entire shoe of Adidas AG is the removable midsole section claimed in claims 11, 14-20 and 22 on the basis that "... (all shoes are removable from overshoes, thereby the definition of overshoe)..." However, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Adidas AG does not teach or suggest an overshoe nor does Adidas AG contemplate that its shoe would be insertable and removable into an overshoe that is "designed to receive and retain said removable midsole section" as required by claim 11. Therefore, the applicant respectfully requests that the rejection of claims 11, 14-20, 22 and 25-31 under 35 U.S.C. §102(b) as being anticipated by Adidas AG be withdrawn upon reconsideration.

Claim 25 of the present application requires, "A removable midsole section sized to fit inside and form part of the sole of a shoe designed to receive and retain said removable midsole section; ...wherein said removable midsole section is removable from said shoe." The Adidas AG invention is a method for permanently assembling a shoe outer sole, midsole, upper, and toe piece. Adidas AG does not teach or suggest a removable midsole section as claimed in claim 25.

Specifically, the Examiner relies on a combination of elements 12 and 14 of Adidas AG as together forming a "removable midsole orthotic" as claimed.¹ However, Adidas AG teaches at page 12, lines 7-13 that,

"The outsole [14] is then attached to the upper by a stitch 80 that weaves around the outer perimeter of the openings thereby connecting the upper 16 to the outsole flanges (e.g., flange 70 in Fig. 8) and the attachment surface 68 (in FIG. 6) of the outsole [14]. In addition, an adhesive can be applied to the attachment surface and/or the interior receiving surface of the upper before the outsole [14] is inserted into the upper to provide an additional bond between the upper and the outsole [14]."

Also, Adidas AG states that,

"the midsole [12] is then inserted into the interior cavity of the upper and affixed to the top side of the outsole [14] ... An adhesive can be used on the bottom side of the midsole 12 to secure the midsole [12] to the outsole [14]. ... A last 82 is then inserted into the cavity of the upper in order to apply pressure to the midsole [12] to strengthen the bond between the midsole [12] and the outsole [14]..."

Clearly the outsole 14 of Adidas AG is permanently attached to the upper and thus is not removable. Also, the midsole 12 of Adidas AG is permanently affixed to the outsole 14 and thus is also not removable. Thus, Adidas AG does not teach the

¹ Again, the applicant has treated the Examiner's references to a "removable midsole orthotic" as being an error and thus intended as references to a "removable midsole section" for the purpose of this response.

removable midsole section as claimed in the present claims since the midsole 12 of Adidas AG is permanently attached to the outsole 14, which, in turn, is permanently attached to the upper. Therefore, the combination of elements 12 and 14, relied upon by the Examiner as anticipating the claimed removable midsole section, is not removable. If these elements of the shoe sole of Adidas AG were removed by, for example, destroying the permanent attachment between the outsole and the upper, it would render the shoe unsuitable for its intended purpose since the shoe would be irreversibly damaged.

"Anticipation" under 35 U.S.C. § 102(b) is established only when single prior art reference discloses, expressly or under principles of inherency, each and every element of claimed invention. See *RCA Corp., supra*. Because Adidas AG does not teach or suggest the removable feature of the removable midsole section of the present invention, it clearly cannot anticipate claim 25, or any of claims 26-31, all of which depend from claim 25.

Finally, the Examiner appears to take the alternative position that the entire shoe of Adidas AG is the removable midsole section claimed in claims 25-31 on the basis that "... (all shoes are removable from overshoes, thereby the definition of overshoe)..."

However, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as

is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Adidas AG does not teach or suggest an overshoe nor does Adidas AG contemplate that its shoe would be insertable and removable into an overshoe that is "designed to receive and retain said removable midsole section" as required by claims 25-31. Moreover, if the Examiner takes the position that the entire shoe of Adidas AG is the removable midsole section, then there is also no disclosure in Adidas AG that the plurality of projections "...interact with the shoe to retain said removable midsole section in said shoe..." since Adidas AG does not even mention the possibility of an overshoe which could retain the shoe of Adidas AG and interact with the projections.

Therefore, the applicant respectfully requests that the rejection of Claims 25-31 under 35 U.S.C. §102(b) as being anticipated by Adidas AG, be withdrawn upon reconsideration.

Claims 39-44 have been rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by WO 97/46127 (Adidas AG). This rejection is respectfully traversed and reconsideration is requested for the reasons, which follow.

Claims 39-44 of the present application require, "A removable midsole section ...wherein said removable midsole section is removable from the outer shoe..." The Adidas AG invention is a method for permanently assembling a shoe outer sole, midsole, upper, and toe piece. Adidas AG does not teach or suggest a removable midsole section, as claimed in claims 39-44.

Specifically, the Examiner relies on a combination of elements 12 and 14 of Adidas AG as together forming a "removable midsole orthotic" as claimed.² However, Adidas AG teaches at page 12, lines 7-13 that,

"The outsole [14] is then attached to the upper by a stitch 80 that weaves around the outer perimeter of the openings thereby connecting the upper 16 to the outsole flanges (e.g., flange 70 in Fig. 8) and the attachment surface 68 (in FIG. 6) of the outsole [14]. In addition, an adhesive can be applied to the attachment surface and/or the interior receiving surface of the upper before the outsole [14] is inserted into the upper to provide an additional bond between the upper and the outsole [14]."

Also, Adidas AG states that,

"the midsole is then inserted into the interior cavity of the upper and affixed to the top side of the outsole ... An adhesive can be used on the bottom side of the midsole 12 to secure the midsole to the outsole. ... A last 82 is then inserted into the cavity of the upper in order to apply pressure to the midsole to strengthen the bond between the midsole and the outsole ..."

Clearly the outsole 14 of Adidas AG is permanently attached to the upper and thus is not removable. Also, the midsole 12 of Adidas AG is permanently affixed to the outsole 14 and thus is also not removable. Thus, Adidas AG does not teach the removable midsole section as claimed in the present claims since the midsole 12 of Adidas AG is permanently attached to the outsole 14, which, in turn, is permanently attached to the upper. Therefore, the combination of elements 12 and 14, relied upon by the Examiner as anticipating the claimed removable midsole section, is not removable. If these elements of the shoe sole of Adidas AG were removed by, for example, destroying the permanent attachment between the outsole and the upper, it

² Again, the applicant has treated the Examiner's references to a "removable midsole orthotic" as being an error and thus intended as references to a "removable midsole section" for the purpose of this response.

would render the shoe unsuitable for its intended purpose since the shoe would be irreversibly damaged.

The Examiner's only attempt to support his position that Adidas AG discloses a removable midsole section is a parenthetical reference to Fig. 22 of Adidas AG. However, Fig. 22 is part of a series of figures in the Adidas AG reference that are employed to illustrate how to assemble the shoe of Adidas AG. See e.g. p. 11, lines 27-28 of Adidas AG, "The method of constructing the shoe according to the invention will now be described with reference to FIGS. 20-26." Thus, Fig. 22 shows one step in the method of constructing the shoe of Adidas AG, i.e. the insertion of the midsole 12 into the shoe. Fig. 22 does not teach or suggest that the midsole 12 is removable from the shoe once it is attached as described above. Thus, there is no support in the Adidas AG reference for the Examiner's position.

"Anticipation" under 35 U.S.C. § 102(b) is established only when single prior art reference discloses, expressly or under principles of inherency, each and every element of claimed invention. See *RCA Corp., supra*. Because Adidas AG does not teach or suggest the removable feature of the removable midsole section of the present invention, it clearly cannot anticipate any of claims 39-44.

Finally, the Examiner appears to take the alternative position that the entire shoe of Adidas AG is the removable midsole section claimed in claims 39-44 on the basis that "... (all shoes are removable from overshoes, thereby the definition of overshoe)..." However, a claim is anticipated only if each and every element as set forth in the claim

is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Adidas AG does not teach or suggest an overshoe nor does Adidas AG contemplate that its shoe would be insertable and removable into an overshoe. Since claims 39-44 expressly require an shoe for receiving the removable midsole section that includes an upper and a bottom sole, this interpretation of Adidas AG would fail to anticipate claims 39-44 since if the entire shoe of Adidas AG were the removable midsole section, there would be nothing left in Adidas AG to anticipate the shoe for receiving the removable midsole section that has an upper and a bottom sole, as claimed in claims 39-44.

Therefore, the applicant respectfully requests that the rejection of Claims 39-44 under 35 U.S.C. §102(b) as being anticipated by Adidas AG be withdrawn upon reconsideration.

The Examiner rejected claims 32-38 as unpatentable under 35 U.S.C. § 103(a) over Adidas AG in view of U.S. Patent no. 5,425,186 (Hoyt). In support of this rejection, the Examiner took the position that Adidas AG was to be applied as it was applied to claim 25 above in the anticipation rejection of claim 25. The Examiner then relied on Hoyt as teaching that an overshoe, which consists of a shoe upper 32 and sole 12, 14, can cover a shoe. The Examiner then concluded that the overshoe can be placed over

a shoe to protect it from wear and tear as well as inclement weather. From this, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to place the shoe of Adidas AG in the overshoe of Hoyt.

Also, with respect to claim 33, the Examiner took the position that Hoyt shows a portion of a side of a shoe upper attached directly to the bottom sole 12, 14. Thus, it is important to note that the Examiner has taken the position that the shoe upper and the bottom sole, as claimed in claims 33-39 of the present application, are provided by the Hoyt overshoe.

According to M.P.E.P. § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** [Emphasis added and Citations omitted]

Applying this requirement, at least two features of claim 32 are not found in a combination of Adidas AG with Hoyt, namely, that the plurality of protrusions on at least one side of the removable midsole section interact with the shoe to retain the removable midsole section in the shoe, and that the outer surface of each of the plurality of protrusions must be formed by midsole.

There is no teaching or suggestion in either Adidas AG or Hoyt that the plurality of protrusions on at least one side of the removable midsole section interact with the shoe to retain the removable midsole section in the shoe.

Specifically, according to the Examiner, the shoe of claim 32 is the overshoe of Hoyt and the removable midsole section of claim 32 is the entire shoe of Adidas AG. Reviewing the references, it is clear that Adidas AG does not contemplate that its shoe would be inserted into an overshoe. Thus, the Examiner must rely on Hoyt for this teaching. However, Hoyt also teaches that the overshoe should stretch in a longitudinal direction to fit each shoe. As a result, the overshoe of Hoyt would be retained on the shoe of Adidas AG by a combination of the portion of the upper that extends over the top of the forefoot area of the shoe and the tendency of the Hoyt overshoe to snugly fit over the toe and heel of the Adidas AG shoe due to it having to be stretched in the longitudinal direction to fit the Adidas AG shoe. Clearly neither of these ways of retaining the Hoyt overshoe on the Adidas AG shoe involve an interaction of protrusions on the side of the Adidas AG shoe with the Hoyt overshoe.

In fact, Hoyt does not provide sufficient information to determine whether protrusions on the side of the Adidas AG shoe would even contact the Hoyt overshoe since Hoyt contains no teaching of how wide the Hoyt overshoe should be relative to any shoe that will be inserted within it. Accordingly, the skilled person cannot derive this feature of claim 32 from a combination of Hoyt with Adidas AG.

In addition, claim 32 depends from claim 25. Claim 25 has been amended to require that the outer surface of the protrusions of the removable midsole section is formed by midsole. This limitation is also not taught or suggested by the combination of adidas AG and Hoyt since the outer surface of the adidas AG shoe is formed by either

upper or bottom sole but not midsole. In other words, the midsole of Adidas AG is contained entirely within the upper and outsole of Adidas AG and thus has no exposed surface to abut with the upper of the overshoe of Hoyt. Thus, Adidas AG does not teach or suggest the provision of protrusions having an outer surface formed by midsole, as is now claimed in claim 32 of the present application. Hoyt also does not teach this feature of the present invention.

Therefore, since at least two elements of claim 32 are missing from a combination of Hoyt with Adidas AG, the Examiner has not made out a case of *prima facie* obviousness and thus the rejection of claim 32 under 35 U.S.C. §103(a) over a combination of Adidas AG and Hoyt should be withdrawn upon reconsideration for at least these reasons.

Claims 33-38 all depend from claim 32 and thus are considered to be patentable over Adidas AG taken in combination with Hoyt for at least the same reasons as given above with respect to claim 32.

In addition, claims 33-38 require that the at least two protrusions on the side of the removable midsole section are in abutting relationship with the bottom sole when the removable midsole section is inside the shoe, so that the protrusions occupy corresponding recesses in the bottom sole to thereby releasably retain said removable midsole section in said shoe.

The only comment made by the Examiner in relation to claim 33 is that, "With respect to claims [sic] 34, the shoe upper 32 would abut at least a portion of the outer

surface of the midsole (after midsole is placed within the overshoe)." First, this statement is incorrect as it applies to this rejection since, according to the Examiner, the shoe upper, as claimed in claims 33-38, is provided by the overshoe of Hoyt. As a result, when the shoe of Adidas AG is inserted into the overshoe of Hoyt, the upper of Hoyt will not abut the midsole of Adidas AG since the midsole of Adidas AG is contained entirely within the upper and outsole of Adidas AG and thus has no exposed surface to abut with the upper of the overshoe of Hoyt.

Secondly, the overshoe of Hoyt does not contain "corresponding recesses in the bottom sole" as required by claims 33-38. Thus, this additional element of claims 33-38 is completely missing from a combination of Adidas AG and Hoyt. Therefore, since at least three elements of claims 33-38 are missing from a combination of Adidas AG and Hoyt, the applicant respectfully requests that the rejection of claims 33-38 under 35 U.S.C. §103(a) as being unpatentable over Adidas AG in view of Hoyt be withdrawn upon reconsideration.

Claims 12-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adidas AG as applied to claim 11 above in view of U.S. Patent No. 5,813,142 (Demon). This rejection is respectfully traversed and reconsideration is requested for the reasons, which follow.

The Examiner takes the position that,

"WO '127 [Adidas AG] discloses all of the limitations of the claim except for the compartment containing a fluid, a flow regulator, a duct, a control system that automatically adjusts the pressure in the compartment, and a microcomputer. Demon '142 teaches that a shoe sole can be modified to contain a compartment containing a fluid, a flow regulator, a duct, a

control system automatically adjusting the pressure in the compartment, and a microcomputer, substantially as claimed. Therefore, it would have been obvious to provide the shoe midsole of WO '127 [Adidas AG] with the system of Demon 142 to reduce the impact of the user's foot on the traveling surface during use."

According to M.P.E.P. § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** [Emphasis added and citations omitted]

Claims 12-13 depend from claim 11. As discussed above with respect to the anticipation rejection of claim 11, Adidas AG does not teach the feature of claim 11 that the removable midsole section must be removable from the outer shoe. Demon also does not teach these features of claim 11. Accordingly, neither of the cited references teaches or suggests these features of claims 12-13 and thus claims 12-13 are clearly patentable over a combination of Adidas AG and Demon for at least this reason.

Further, the feature of claim 12 that requires the controller to be located in the inner shoe is not found in either Adidas AG or Demon. Adidas AG does not even disclose a controller. Demon teaches that the controller should be located in the shoe upper (See Fig. 1 of Demon).

In addition, the present invention represents a non-obvious improvement over Adidas AG in view of Demon with respect to the location of the controller. Demon teaches that the controller 300 should be situated in the shoe's upper (see Figure 1)

where it is exposed to the torsion created by the wearer during use. In the present invention, the controller is located within the inner shoe. Positioning the controller in the inner shoe greatly reduces the torsion problems associated with the situating the controller in the shoe upper. Also, if the midsole section of Demon were made removable as the examiner suggests, it would be necessary to disconnect the controller prior to removing the midsole section since the controller 300 of Demon is located in the shoe upper.

Also, the controller in Demon is designed only to regulate the ambient air entering into and exiting from bladders located in the non-removable shoe sole. Therefore, one would have to modify the controller as taught in Demon to function in two different platforms: the inner shoe worn independently of the other parts of the shoe and the inner shoe worn as part of the complete shoe, in order to arrive at the present invention. There is no teaching or suggestion in either Adidas AG or Demon to do so.

Finally, the Examiner takes the position that it would be obvious to provide the shoe midsole of Adidas AG with the system of Demon to reduce the impact of the user's foot on the traveling surface during use. However, certain important features of the system of Demon would lead a skilled person away from combining the system of Demon with the shoe of Adidas AG.

The system of Demon is spread out over both the shoe sole and the shoe upper as shown in Fig. 1 of Demon. Therefore, the controller of Demon would reside in the upper 18 of Adidas AG and other elements of the system of Demon would reside in the

midsole portion 12 of Adidas AG. As a result, there must be a connection between the control system in the upper 18 and the other elements in the midsole portion 12. This will make the shoe construction method of Adidas AG impractical since the shoe construction method of Adidas AG employs a midsole 12 that is a single integral piece that is separate from the upper 18. See e.g. Fig. 22 of Adidas AG. This is because it would be extremely difficult to provide the connection between the upper and the midsole portion using the construction method of Adidas AG since separate portions of the connector would have to be fabricated in the upper and in the midsole portion. Moreover, there is very little contact between the midsole portion of Adidas AG and the upper, thereby limiting the locations where a suitable connection could be made, i.e. it appears from Figs. 20-26 of Adidas AG that a connection between the upper and the midsole portion could only be made in a small portion of the side of the forefoot portion of the midsole portion since otherwise it would be necessary for such a connection to pass through the outsole as well, thereby further complicating the manufacturing process.

The present invention, therefore, clearly represents a non-obvious advancement in the art over Adidas AG in view of Demon. Accordingly, the applicant respectfully requests that the rejection of claims 12-13 under 35 U.S.C. §103(a) as being unpatentable over Adidas AG in view of Demon be withdrawn upon reconsideration.

Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Adidas AG as applied to claim 11 above in view of Vizy et al. This rejection is respectfully traversed and reconsideration is requested for the reasons, which follow.

The Examiner takes the position that,

“WO ‘127 [Adidas AG] discloses all of the limitations as claimed except for an insole located within the midsole orthotic shoe [sic – removable midsole section]. Vizy et al. ‘857 teaches in column 1, lines 6-28 that is [sic] typical in a shoe to include an insole to aid in comforting the user’s foot. Therefore, it would have been obvious, in view of Vizy et al. ‘857, to place an insole on top of the midsole of the WO ‘127 [Adidas AG] reference to aid in giving comfort to the user’s foot during wear.”

According to M.P.E.P. § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** [Emphasis added and citations omitted]

Claim 21 depends from claim 11. As discussed above with respect to the anticipation rejection of claim 11, Adidas AG does not teach the feature of claim 11 that the removable midsole section must be removable from the outer shoe. Vizy et al. also does not teach this feature of claim 11 and the Examiner does not allege that Vizy et al. teaches this missing feature. Accordingly, neither of the cited references teaches or suggests this feature of claim 21 and thus claim 21 is clearly patentable over a combination of Adidas AG and Vizy et al. for at least this reason.

Accordingly, the applicant respectfully requests that the rejection of Claim 21 under 35 U.S.C. §103(a) as being unpatentable over Adidas AG in view of Vizy et al. be withdrawn upon reconsideration.

Claims 25-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adidas AG as applied to claim 11 above in view of Hoyt. This rejection, at least insofar as it applies to claims 25-26, as amended, is respectfully traversed and reconsideration is requested for the reasons, which follow.

The Examiner takes the position that,

"The WO '127 [Adidas AG] reference as applied to claim 11 above discloses all of the limitations of the [sic - these] claims except for the shoe upper and shoe sole. Hoyt '186 teaches that a shoe can be covered by an overshoe which consists of a shoe upper 32 and sole 12, 14. This overshoe can be placed over a shoe to protect it from wear and tear as well as inclement weather. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to place the shoe of WO '127 [Adidas AG] in the overshoe of Hoyt '186 to protect the shoe from excessive wear and tear as well as inclement weather."

According to M.P.E.P. § 2143,

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** [Emphasis added and citations omitted]

Applying this requirement, at least two features of claims 25-26 are not found in a combination of Adidas AG with Hoyt, namely, that the plurality of protrusions on at least one side of the removable midsole section are of sufficient size to interact with the

shoe to retain the removable midsole section in the shoe, and that the outer surface of each of the plurality of protrusions must be formed by midsole.

Neither Adidas AG nor Hoyt teaches or suggests that the plurality of protrusions on at least one side of the removable midsole section are of sufficient size to interact with the shoe to retain the removable midsole section in the shoe.

Specifically, according to the Examiner, the shoe of claims 25-26 is the overshoe of Hoyt and the removable midsole section of claims 25-26 is the entire shoe of Adidas AG. Reviewing the references, it is clear that Adidas AG does not contemplate that its shoe would be inserted into an overshoe. Thus, the Examiner must rely on Hoyt for this teaching. However, Hoyt also teaches that the overshoe should stretch in a longitudinal direction to fit each shoe. As a result, the overshoe of Hoyt would be retained on the shoe of Adidas AG by a combination of the portion of the upper that extends over the top of the forefoot area of the shoe and the tendency of the Hoyt overshoe to snugly fit over the toe and heel of the Adidas AG shoe due to it having to be stretched in the longitudinal direction to fit the Adidas AG shoe. Clearly neither of these ways of retaining the Hoyt overshoe on the Adidas AG shoe involve an interaction of protrusions on the side of the Adidas AG shoe with the Hoyt overshoe.

In fact, Hoyt does not provide sufficient information to determine whether protrusions on the side of the Adidas AG shoe would even contact the Hoyt overshoe since Hoyt contains no teaching of how wide the Hoyt overshoe should be relative to

any shoe that will be inserted within it. Accordingly, the skilled person cannot derive this feature of claims 25-26 from a combination of Hoyt with Adidas AG.

In addition, claim 25 has been amended to require that the outer surface of the protrusions of the removable midsole section is formed by midsole, and claim 26 includes this limitation by virtue of being dependent on claim 25. This limitation is also not taught or suggested by the combination of adidas AG and Hoyt since the outer surface of the adidas AG shoe is formed by either upper or bottom sole but not midsole.

In other words, the midsole of Adidas AG is contained entirely within the upper and outsole of Adidas AG and thus has no exposed surface to abut with the upper of the overshoe of Hoyt. Thus, Adidas AG does not teach or suggest the provision of protrusions having an outer surface formed by midsole, as is now claimed in claims 25-26 of the present application. Hoyt also does not teach this feature of the present invention.

Therefore, since at least two elements of claims 25-26 are missing from a combination of Hoyt with Adidas AG, the Examiner has not made out a case of *prima facie* obviousness and thus the rejection of claims 25-26 under 35 U.S.C. §103(a) over a combination of Adidas AG and Hoyt should be withdrawn upon reconsideration for at least these reasons.

Claims 11-44 of the present application have been rejection on the based of same invention-type double patenting over claims 11-45 of U.S. patent application no.

U.S. Application No. 09/527,019

09/558,629. This rejection is respectfully traversed and reconsideration is requested for the reasons, which follow.

Specifically, all of claims 11-45 of copending application no. 09/558,629 require an "insertable midsole orthotic" whereas claims 11-44 of the present application require a "removable midsole section." Clearly, these claim limitations are not of identical scope since claims 11-45 of copending application no. 09/558,629 use the term, "orthotic." An orthotic is a podiatric, orthopedic, corrective, therapeutic, prosthetic or prescriptive device. See page 62, lines 21-23 of the original specification of application no. 09/558,629. The present application does not expressly claim such an orthotic device. The Examiner does not provide any evidence as to why the present claims claim an orthotic device. Thus, since claims 11-44 of the present application are not identical in scope to claims 11-45 of copending application no. 09/558,629, this rejection should be withdrawn upon reconsideration.

Claims 11-44 have been provisionally rejected under the judicially-created doctrine of obviousness double patenting as being unpatentable over claims 11-45 of copending application no. 09/558,629. The applicant will defer action on this rejection until the claims of one of the two applications have been allowed.

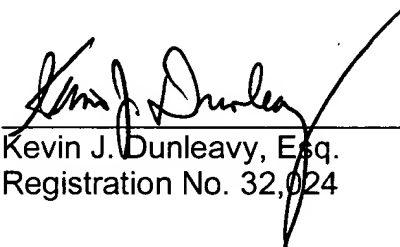
U.S. Application No. 09/527,019

Favorable consideration and issuance of a Notice of Allowance are requested.

Respectfully submitted,

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REDLINE VERSION OF CLAIMS SHOWING AMENDMENTS

25. (Amended) A removable midsole section sized to fit inside a shoe and form part of the shoe designed to received and retain said removable midsole section, which comprises:

an inner surface and an outer surface which together define the removable midsole section having a lateral side, a medial side and a middle portion located between the lateral and medial sides;

a plurality of protrusions on at least one side of said removable midsole section, each of said protrusions having an outer surface formed by midsole, and wherein said protrusions that are of sufficient size to interact with the shoe to retain said removable midsole section in said shoe;

at least one portion of the outer surface of each said protrusion is concavely rounded relative to an inner section of the removable midsole section adjacent to the concavely rounded outer surface portion, as viewed in a frontal plane cross-section when the removable midsole section is upright and in an unloaded condition;

at least one portion of an inner surface of a side of the removable midsole section is convexly rounded relative to a section of the removable midsole section directly adjacent to the convexly rounded inner surface portion, as viewed in a frontal plane cross-section when the removable midsole section is upright and in an unloaded condition; and

wherein said removable midsole section is removable from said shoe.